

PATENT
5596-00300

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application No.: 09/613,339
Filed: July 10, 2000
Inventor:
Nobuyoshi Morimoto

Title: System and Method for
Negotiating Improved
Terms for Products and
Services Being Purchased
Through the Internet

§ Examiner: Elisca, Pierre E.
§ Group/Art Unit: 3621
§ Atty. Dkt. No: 5596-00300
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Robert C. Kowert

Name of Registered Representative

Signature

October 26, 2005

Date

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop AF

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Applicant requests review of the Examiner's rejection in the above-identified application. No amendments are being filed with this request. This request is being filed with a notice of appeal. The review is requested for the reason(s) stated below.

Claims 1-44 remain pending in the application. Reconsideration of the present application is earnestly requested in light of the following remarks. Please note that for brevity, only the primary arguments directed to the independent and some of the dependent claims are presented, and that additional arguments directed to the subject matter of others of the dependent claims, will be presented if and when the case proceeds to Appeal.

The Examiner rejected claims 1-44 under 35 U.S.C. § 103(a) as being unpatentable over Kinney, Jr. et al. (U.S. Patent 6,871,191) (hereinafter "Kinney") in view of Treyz et al. (U.S. Patent 6,587,835) (hereinafter "Treyz"). Applicant respectfully traverses this rejection for at least the following reasons. **Applicant submits that the Examiner has failed to provide a prima facie rejection of each of the independent claims.** Applicant notes the following clear errors in the Examiner's rejection.

Regarding claim 1, Kinney in view of Treyz fails to teach or suggest *detecting an issuance of a commitment to purchase with associated terms for the product or service being purchased by a purchaser using an Internet web site*. The Examiner fails to mention or cite any portion of the prior art that teaches or suggests this limitation. Therefore, the Examiner has not stated a prima facie rejection for claim 1. To establish a prima facie rejection based on obviousness, all claim limitations must be taught or suggested by the prior art. In re Royka, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974), MPEP 2143.03. No portion of Treyz, nor of Kinney, mentions anything about *detecting an issuance of a commitment to purchase* with associated terms for the product or service being purchased by a purchaser using an Internet web site, as recited in claim 1, nor a need for detecting an issuance of a commitment to a purchase. Treyz is concerned with providing shopping assistance to shoppers in shopping malls, not purchasers using an Internet web site, while Kinney discloses a method and system for conducting an on-line auction, which does not involve *detecting a commitment to purchase* an item over the Internet. Instead, Kinney's auction system involves combining multiple, independent partial quantity bids to be combined to meet an auction's quantity requirements.

Also regarding claim 1, contrary to the Examiner's assertion, Kinney in view of Treyz fails to teach or suggest *in response to said detecting, making an offer to a purchaser to accept or reject a contract for negotiating improved terms within a specified time*. The Examiner's citations (Kinney, abstract, column 9, lines 30-39, and column 10, line 1-14) describe an online auction in which partial quantities of commodity items may be bid on and in which individual bids for partial quantities may be accepted or rejected by the auction server component. As discussed above, there is no detection of an issuance of a commitment to purchase in Kinney's auction system. There is also no contract being offered to a purchaser for negotiating improved terms within a specified time. Bidding in an online auction has absolutely nothing to do with making or receiving any offer to accept or reject a contract for negotiating improved terms. Finally, there are no purchase terms for which to negotiate an improvement at this point, because the purchaser has not agreed to buy anything yet. Instead, before an auction, Kinney describes an Initial Contact phase of the auction process, in which an auction coordinator contacts a buyer and works with the buyer to specify the product or service needed and to prepare a Request for Quote (column 2, lines 56-60 and column 3, lines 5-14). At no time does the coordinator *offer a purchaser a contract to negotiate improved terms* for a purchase. In fact, the only contract mentioned in Kinney is between a buyer and a supplier if business is awarded to the supplier. (column 3, lines 41-44). However, as noted above the contract in Kinney is not a contract for negotiating improved terms for a product or service being purchased. Nor is the contract in Kinney offered in response to detecting an issuance of a commitment to purchase the product or service. Nothing in Treyz overcomes the above noted deficiencies of Kinney.

Further regarding claim 1, Kinney in view of Treyz fails to teach or suggest *the purchaser accepting the offer*. The Examiner's citations (column 9, lines 30-39, column 10, lines 1-4, column 15 and column 16) refer to a buyer accepting bids for a partial or complete quantity of desired products or services during an online auction. Bids are not contracts for negotiating improved terms for committed purchases. Nothing in the Examiner's cited portions refer to a purchaser *accepting an offer of a contract for negotiating improved terms*, as is recited in claim 1. As noted above, nothing in Kinney's auction system, nor in Treyz' shopping assistance system involves a purchaser accepting an offer of a contract for negotiating improved terms.

Kinney in view of Treyz also fails to teach or suggest if the purchaser accepts the offer, *conducting a search for said improved terms within said specified time; receiving said improved terms within said specified time; and executing said contract*. The Examiner relies on

the same portions of Kinney as discussed in the previous paragraph (column 9, lines 30-39, column 10, lines 1-4, column 15 and column 16). However, as discussed above, these citations describe an online auction in which suppliers bid to provide partial quantities of desired products or services. The Examiner apparently contends that Kinney's online auction somehow includes conducting a search for improved terms within a specified time, receiving the improved terms within the specified time and executing the contract. However, Kinney's system only involves an online auction and auctions do not involve searching for and receiving improved terms within a specified time and executing a contract for the improved terms if a purchaser accepts an offer for the contract for negotiating improved terms. Instead, Kinney's online auction involves simply bidding by multiple parties and the ability to combine independent small quantity bids during the auction. There is nothing in the Examiner's citation, nor elsewhere in Kinney, Treyz, or the combination of the two, to teach or suggest conducting a search within a specified time for improved in regard to the terms associated with a previously committed purchase. The auction biddings cited by the Examiner are not searches for improved terms, do not involve a contract for negotiating improved terms, and are completely silent as to any specified time for receiving such improved terms.

The Examiner admits that Kinney fails to disclose a commitment to purchase with associated terms for said product and relies on Treyz to disclose "a system in which users make financial commitment toward purchases" (abstract, column 1, lines 49-52, and column 11, lines 63-67). Treyz teaches a system in which a handheld computing device may be used to provide a user with shopping assistance when physically present, in person, in a retail shopping mall (Abstract). The Examiner cites column 1, lines 49-52 where Treyz describes how users of his handheld device may make financial commitments toward purchases prior to completing purchase transactions. The Examiner also cites column 11, line 63 – column 12, line 10 describing how manufactures may provide a discount or otherwise subsidize a purchase if an item is purchased from that manufacturer. Neither of the cited passages nor any other portion of Treyz mentions anything about having *detected an issuance of a commitment to purchase* with associated term for the product or service being purchased by a purchaser *using an Internet web site*, as recited in Claim 1. As discussed above, Treyz is concerned with providing shopping assistance to shoppers *in shopping malls*, not purchasers using an Internet web site. Furthermore, the shopping assistance provided by Treyz has absolutely no bearing on Kinney's method and system for conducting an on-line auction.

The Examiner contends that it would be obvious to a person of ordinary skill in the art at the time the invention was made to modify the teachings of Kinney by including the limitation detailed above as taught by Treyz "because this would provide *commitment toward purchases prior to completing purchase transactions*." This language "commitment toward purchases prior to completing purchase transactions" is taken directly from Treyz (column 4, lines 50-51). There is nothing in Kinney to suggest that such a feature is necessary or even desirable in the system and method of Kinney. In fact, in Kinney, even when a bidding period is over, the buyer retains the right not to award business to a low bidding supplier based on final qualification results or other business concerns (column 3, lines 32-40). Therefore, clearly, there is no "commitment to purchase" required or suggested in the on-line auction of Kinney.

Furthermore, even if Kinney was modified according to Treyz so that a participant in an on-line auction made a commitment to purchase, such a modification would still not teach or suggest *a purchaser being offered a contract* to negotiate improved terms for a purchase *in response to a commitment to such a purchase being detected*, as recited by claim 1. As Treyz' system has nothing to do with online auctions, and as Kinney's system has nothing to do with

providing shopping assistance to people shopping in brick and mortar stores, modifying Kinney in view Treys would not affect the manner in which Kinney's auctions are implemented.

Similar remarks as discussed above in regard to claim 1 also apply also to independent claims 29, 41, 42, and 44.

Also in regard to claim 29, Kinney in view of Treyz fails to teach or suggest offering the purchaser an opportunity to enter into an alternative contract in which the purchaser agrees to wait a predetermined amount of time in exchange for a possibility of securing a better price for said particular item or service. **The Examiner has not made any arguments, nor cited any passage of prior art, regarding this limitation of claim 29.** Instead, the Examiner has merely listed claim 29 with the rejection of claim 1, even though claim 1 and claim 29 recite different limitations. **Therefore, the Examiner has not stated a *prima facie* rejection for claim 29.** Moreover, there is no description in either Kinney or Treyz, whether considered singly or in combination, to teach or suggest offering a purchaser an opportunity to enter into an alternative contract in which the purchaser agrees to wait a predetermined amount of time in exchange for a possibility of securing a better price for a particular item or service.

Furthermore, the cited art fails to teach, or suggest, if said better price is found before said predetermined amount of time expires, purchasing the particular item or service for the purchaser at the better price and charging the purchaser a new price between said particular price and said better price. Again, the Examiner has not made any arguments, nor cited any passage of prior art, regarding this limitation of claim 29. Instead, as noted above, the Examiner has merely listed claim 29 with the rejection of claim 1. There is no description in either Kinney or Treyz regarding purchasing an item at a better price and charging the purchaser a price between the better price and the particular price. Neither the shopping assistance provided by Treyz nor the on-line auction of Kinney has anything to do with making such a purchase at a better price and charging the purchaser a new price between the better price and an original price. Similar remarks apply also to claim 41, which includes this limitation.

In further regard to claim 41, Kinney in view of Treyz fails to teach or suggest automatically delaying the purchase for a predetermined amount of time. Once again, the Examiner fails to cite any portion of Kinney or Treyz that mentions anything regarding automatically delaying a purchase for a predetermined amount of time. **In fact, the Examiner has completely ignored this limitation of claim 41 and has, instead, merely listed claim 41 with his rejection of claim 1.** As discussed above, the on-line auction of Kinney and the shopping assistance provided by Treyz have nothing to do with delaying a purchase while a search is conducted for better terms. Thus, no combination of Kinney and Treyz teaches the limitations recited in claim 41.

Regarding claim 44, Kinney in view of Treyz further fails to anticipate, teach, or suggest in response to detecting an action by a purchaser, accessing a broker-agent web site for seeking a better price for the particular item or service within a predetermined amount of time. Once again, the Examiner fails to cite any portion of Kinney or Treyz that mentions anything regarding accessing a broker-agent web site for seeking a better price. **In fact, the Examiner has completely ignored this limitation of claim 44** and has merely listed claim 44 with his rejection of claim 1. In the on-line auction of Kinney, a list of potential suppliers is prepared by a coordinator and buyer, not obtained through a broker-agent web site. There is nothing about Kinney's online auction system that teaches or suggests seeking a better price for a particular item or service by accessing a broker-agent web site. Additionally, as noted above, Treyz has nothing whatsoever to do with purchasing items over the Internet. Thus, no combination of

Kinney and Treyz would teach or suggest this limitation of claim 44. Moreover, since the Examiner has not mentioned either of the limitations discussed here in his remarks, he has failed to state a prima facie rejection for claim 41.

For at least the reasons above, the Examiner has **failed to provide a prima facie rejection of each of the independent claims.**

The Examiner has also failed to mention or cite any prior art to support his rejection of many of the limitations of the dependent claims. For example, the Examiner includes no remarks regarding the specific limitations of claims 9, 10, 11, 12, 13, 30, 35, 37, 38, 39, 40 and 42.

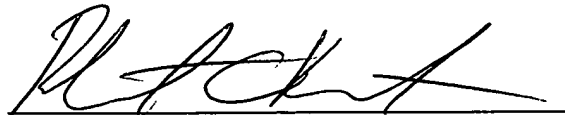
For at least the reasons presented above, the Examiner's rejection is not supported by the prior art and removal thereof is respectfully requested.

In light of the foregoing remarks, Applicant submits the application is in condition for allowance, and notice to that effect is respectfully requested. If any extension of time (under 37 C.F.R. § 1.136) is necessary to prevent the above referenced application from becoming abandoned, Applicant hereby petitions for such extension. If any fees are due, the Commissioner is authorized to charge said fees to Meyertons, Hood, Kivlin, Kowert, & Goetzel, P.C. Deposit Account No. 501505/5596-00300/RCK.

Also enclosed herewith are the following items:

- ☒ Return Receipt Postcard
- ☒ Notice of Appeal

Respectfully submitted,



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